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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

COUGHLAN, PETER D

ART UNIT PAPER NUMBER

2129

DATE MAILED: 06/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/696,942

Applicant(s)

WHITE ET AL.

Examiner

Peter Coughlan

Art Unit

2129

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)     | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

## Detailed Action

1. This office action is in response to an AMENDMENT entered April 26/2006 for the patent application 10/696942 filed on October 30, 2003.
2. The First Office Action of February 17, 2006 is fully incorporated into this Final Office Action by reference.

### ***Status of Claims***

- 3 Claims 1-24 are pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 9 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The term 'system basis' is not clearly defined. In ¶0025 is 'system' a network

system of a customer system? In ¶0032 'system basis' could be the 'system model number'.

5. Claims 5 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 5 and 13 use the term 'system model' but that term is used only in ¶0032 but not clearly defined. The term 'system model identifier' is only used in claims 5 and 13 and nowhere in the specification.

6. Claims 6, 14 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 6, 14 and 20 use the term 'system manufacture' and this term is not defined in the specification. Is it a component (system) manufacture data, or a date when the system (multiple components) was completed?

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 8, 9, 16, 17 and 24 are rejected under 35 U.S.C. 102(e) (hereinafter referred to as **Wu**) being clearly anticipated by Wu et al., U.S. Patent Publication 20040083213.

Claims 1, 9 and 17.

Wu teaches an excursion identifying module (**Wu**, ¶0022; 'Identifying module' of applicant is equivalent to process 102 Figure #1 of Wu.), the excursion identifying module identifying excursions to the general solutions on a system model basis (**Wu**, ¶0051; 'Excursions' of applicant is equivalent to 'attribute criteria' of Wu.); a knowledge repository, the knowledge repository storing information regarding general solutions to issues, the knowledge repository storing information relating to excursions to general solutions, the excursions being searchable on a system model bases (**Wu**, ¶0067; 'Knowledge repository' of applicant is equivalent to 'solution database' of Wu.); a search module, the search module searching the solution network to determine whether an excursion solution exists when accessing the solution network. (**Wu**, ¶0022; 'Search module' of applicant is equivalent to 104 Fig#1 of Wu.)

Claims 8, 16 and 24.

Wu teaches the system includes an information handling system. (Wu, ¶0027;  
'Information handling system' of applicant is equivalent to 'server system' of Wu.)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

***Claim Rejections - 35 USC § 103***

Claims 2, 3, 4, 10, 11, 12, 18, 19, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu, as set forth above, and further in view of Collins. (U. S. Patent Publication 20040243998, referred to as **Collins**)

Claims 2, 10 and 18.

Wu does not teach the excursions are identifiable based upon a unique system identifier.

Collins teaches the excursions are identifiable based upon a unique system identifier. (**Collins**, ¶0022; 'Excursions' and 'unique system identifier' of applicant is equivalent to 'corrupted' and 'unique identifier' of Collins.) It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Wu by using a particular identifier as taught by Collins to have teaches the excursions are identifiable based upon a unique system identifier.

For the purpose of narrowing the scope of search to a given system.

Claims 3, 11 and 19.

Wu does not teach the unique system identifier is a service tag.

Collins teaches the unique system identifier is a service tag. (**Collins**, ¶0022) It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Wu by using a service tag within the unique system field to focus in on a solution as taught by Collins to have the unique system identifier is a service tag.

For the purpose of setting forth the proper configuration of a particular unique system.

Claims 4, 12 and 20.

Wu does not teach storing the excursion exception within the solution network based upon a part identifier.

Collins teaches storing the excursion exception within the solution network based upon a part identifier. (**Collins**, ¶0022; 'Part identifier' of applicant is equivalent to 'express service code' of Collins. Collins states that corrupted software (excursion) is linked (identifiable) to an express service code. (part identifier)) It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Wu by linking the solution to the current situation characteristics as taught by Collins to store the excursion exception within the solution network based upon a part identifier.

For the purpose of obtaining a correct solution for a given excursion.

***Claim Rejections - 35 USC § 103***

Claims 5, 6, 7, 13, 14, 15, 21, 22, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu, as set forth above, and further in view of Markham. (U. S. Patent Publication 20030158795, referred to as **Markham**)

Claims 5, 13 and 21.

Wu does not teach storing the excursion exception within the solution network based upon a system model identifier.

Markham teaches storing the excursion exception (**Markham**, ¶0008; 'Excursion exception' of applicant is equivalent to 'event parameters' of Markham.) within the solution network (**Markham**, ¶0043; 'Solution' of applicant is equivalent to 'maintenance'



of Markham.) based upon a system model identifier (**Markham**, ¶0081; 'System model identifier' of applicant is equivalent to 'vendor' of Markham.)

It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Wu by having routine maintenance required based on vendor type as taught by Markham to store the excursion exception within the solution network based upon a system model identifier.

For the purpose of using vendor type as an input parameter for maintenance schedule.

Claims 6, 14 and 22.

Wu does not teach storing the excursion exception within the solution network based upon a system manufacture date.

Markham teaches storing the excursion exception (**Markham**, ¶0008; 'Excursion exception' of applicant is equivalent to 'event parameters' of Markham.) within the solution network (**Markham**, ¶0043; 'Solution network' of applicant is equivalent to 'maintenance' of Markham.) based upon a system manufacture date. (**Markham**, ¶0081; 'System manufacture date' of applicant is equivalent to 'manufacture date' of Markham.) It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Wu by using manufacturing date as a input parameter routine maintenance as taught by Markham to store the excursion exception within the solution network based upon a system manufacture date.

For the purpose of keeping track of possible poor manufacturing from outside vendors within a given time period.

Claims 7, 15 and 23.

Wu does not teach searching the solution network for general solutions when no excursion solution exists, the searching the solution network to determine whether an excursion solution exists being performed before searching to solution network for general solutions.

Markham teaches searching the solution network for general solutions when no excursion solution exists, the searching the solution network to determine whether an excursion solution exists being performed before searching to solution network for general solutions. (**Markham**, ¶0049; 'Solution network for general solutions' of applicant is equivalent to Markham being integrated to outside systems for solutions.) It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Wu by having another source for possible solutions as taught by Markham to search the solution network for general solutions when no excursion solution exists, the searching the solution network to determine whether an excursion solution exists being performed before searching to solution network for general solutions.

For the purpose of having access to a possible solution when none could be found when using the excursion solution system.

***Response to Arguments***

8. Applicant's arguments filed on April 26/2006 for claims 1-24 have been fully considered but are not persuasive.

9.. In reference to the Applicant's argument:

Claims 1-24 are pending in the application. Claims 1 - 24 have been rejected. Claims 1, 9 and 17 have been amended.

Claims 1, 5, 6, 9, 13, 14, 17 and 20 stand rejected under 35 U.S.C. § 112, first paragraph. This rejection is traversed. However, to expedite prosecution, Applicants have amended some of the rejected claims in an attempt to address this rejection. For example, claims 1, 9 and 17 have been amended to specify a "system model basis". Claims 5 and 13 stand rejected based upon the term "system model identifier". It is respectfully submitted that those skilled in the art would appreciate based upon the specification and claims that a "system model identifier" is an identifier for a system model. Claims 6, 14 and 20 stand rejected based upon the term "system manufacture date". It is respectfully submitted that those skilled in the art would appreciate based upon the specification and claims that a "system manufacture date" is the date on which the manufacture of a system is completed.

Examiner's response:

The term 'system model basis' is not used at all in the specification. 'System model number' and 'system model identifier' are used, but since they are labeled different they must have different meanings. The title of the application is 'Solution network excursion module'. Does 'number' mean IP address or a numerical listing of a list of networks or the number of nodes on the network? Does 'identifier' mean the type of network, token ring or Ethernet, or NIC identifier of every internet card or operating system that runs the 'model'? Is the manufacture date pertinent to the date of the solution or the date of the which the identified excursion was generated on?

10. In reference to the Applicant's argument:

Claims 1, 8, 9, 16, 17 and 24 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Wu et al., U.S. Patent Publication No. 20040083213 (Wu). Claims 2 -- 7, 10 --15, and 18 --23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Collins, et al, U.S. Patent Publication No. 20040243998 (Collins) in view of Markham, U.S. Patent Publication No. 20030158795 (Markham).

The present invention generally relates to a knowledge management system which includes the ability to flag predetermined systems that have a known exception (i.e., an excursion) and render a solution based upon the known excursion.

More specifically, the present invention, as set forth by independent claim 1, relates to a method for identifying excursions to general solutions provided by a solution network. The method includes identifying excursions to a general solution on a system model basis, saving the excursions within the solution network on a model system basis, and when accessing the solution network, searching the solution network to determine whether an excursion solution exists.

The present invention, as set forth by independent claim 9, relates to an apparatus for identifying excursions to general solutions provided by a solution network. The apparatus includes means for identifying excursions to a general solution on a system model basis, means for saving the excursions within the solution network on a system model basis, and means for searching the solution network to determine whether an excursion solution exists when accessing the solution network.

The present invention, as set forth by independent claim 17, relates to a solution network which includes a knowledge repository, an excursion identifying module, and a search module. The knowledge repository stores information regarding general solutions relating to issues and information relating to excursions to general solutions. The excursions are searchable on a system model basis. The excursion identifying module identifies excursions to the general solutions on a system basis. The search module searches the solution network to determine whether an excursion solution exists when accessing the solution network.

Wu discloses solution searching. More specifically, Wu provides for solution searching during a session with a user. The user creates a search request for a solution. A data store provides refinement criteria that are displayed to the user. The refinement criteria are associated with the search request. The user then selects the refinement criteria. In response, the data store provides solutions that are displayed to the user.

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The solutions are associated with the search request and the selected refinement criteria. The user selects the solutions. The search request, the selected refinement criteria, and the selected solutions for the session are then stored in the data store.

Collins discloses restoring a software image of a customer information handling system to the same software image the system had when leaving the factory. The customer information handling system enters a re-imaging mode where the system requests a software download server to recreate the software image originally shipped with that particular information handling system. Once the replacement software image is created, the customer information handling system downloads the replacement software image to the media drive of the customer information handling system.

Markham relates to quality management and manufacturing with labels and smart tags in event based product manufacturing. Markham discloses a process control system which includes sensors which generate an alarm in response to art event. (See e.g., Markham 18) Markham sets forth that events may affect productivity of a process and that adverse productivity events are events that adversely affect the productivity of a process. (See e.g., Markham 142.)

Wu, Collins and Markham, taken alone or in combination, do not teach or suggest a method for identifying excursions to general solutions provided by a solution network much less such a method which includes identifying excursions to a general solution on a system model basis, saving the excursions within the solution network on a system model basis, and when accessing the solution network, searching the solution network to determine whether an excursion solution exists, all as required by claim 1. Accordingly, claim 1 is allowable over Wu, Collins and Markham. Claims 2 - 8 depend from claim 1 and are allowable for at least this reason.

Wu, Collins and Markham, taken alone or in combination, do not teach or suggest an apparatus for identifying excursions to general solutions provided by a solution network much less such an apparatus includes means for identifying excursions to a general solution on a system model basis, means for saving the excursions within the solution network on a system model basis, and means for searching the solution network to determine whether an excursion solution exists when accessing the solution network, all as required by claim 9. Accordingly, claim 9 is allowable over Wu, Collins and Markham. Claims 10 - 16 depend from claim 9 and are allowable for at least this reason.

Wu, Collins and Markham, taken alone or in combination, do not teach or suggest a solution network which includes, a knowledge repository and an excursion identifying module, much less such a solution network where the knowledge repository stores information regarding general solutions relating to issues and information relating to excursions to general solutions and the excursions are searchable on a system model basis; the excursion identifying module identifies excursions to the general solutions on a

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system basis; and the search module searches the solution network to determine whether an excursion solution exists when accessing the solution network, all as required by claim 17. Accordingly, claim 17 is allowable over Wu, Collins and Markham. Claims 18 - 24 depend from claim 17 and are allowable for at least this reason.

Examiner's response:

A 'method', 'solution' or a 'apparatus' is taught by Wu that for identifying excursions to general solutions provided by a solution network much less such a method which includes identifying excursions to a general solution on a system model basis (Wu, ¶0022, ¶0051; 'Identifying excursions' and 'Excursions' of applicant is performed by the process 102 Figure #1 and 'attribute criteria' of Wu.), saving the excursions within the solution network on a system model basis (Wu, ¶0067; 'Knowledge repository' of applicant is equivalent to 'solution database' of Wu.), and when accessing the solution network searching the solution network to determine whether an excursion solution exists. (Wu, ¶0022; 'Search module' of applicant is equivalent to 104 Fig#1 of Wu.)

11. In reference to the Applicant's argument:

Additionally, applicants respectfully submit that the combination of Wu, Collins and Markham is improper because Wu, Collins and Markham are nonanalogous prior art that have been combined with the benefit of hindsight and because Wu, Collins and Markham fail to provide a suggestion to be combined.

Wu, Collins and Markham are nonanalogous prior art because Wu relates to search operations, Collins relates to restoring a software image to a customer information handling system and Markham relates to event based product manufacturing.

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The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself .... *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d, 1443, 1446 (Fed. Cir. 1992)

Additionally, even if Wu, Collins and Markham are found to be within analogous arts, Wu, Collins and Markham do not provide a suggestion for such a combination.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Wilson and Hendrix fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner and endorsed by the Board.

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "Eojue cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fritch*, 23 USPQ 2d at 1783-84 (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)).

Further, it appears that the rejection of claims 1, 8, 9, 16, 17 and 24 is based on an improper hindsight-based obviousness analysis. In this regard, it must be recognized that hindsight reconstruction of claims based on disparate aspects of the prior art may not be employed as a valid basis for the rejection of those claims. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303, 312-313 (Fed. Cir. 1983); *Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593, 1595-1596 (Fed. Cir. 1987). Furthermore, an obviousness determination requires that the invention as a whole would have been obvious to a person having ordinary skill in the art. *Connell v. Sears Roebuck & Co.*, 220 USPQ 193 (Fed. Cir. 1983).

To establish obviousness based on a combination of elements disclosed in the prior art or a modification of the prior art, there must be some motivation, suggestion or teaching of the desirability of making the claimed invention. See *In re Dance*, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The motivation, suggestion or teaching to modify references may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved. *In re Demhiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Whether the Office Action relies on an express or implicit showing of a motivation or suggestion to modify or combine references, it must provide particular findings related thereto. *In re Demhiczak*, 50 USPQ2d at 1617. Broad conclusory

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statements standing alone are not "evidence." Id Thus, the Office Action must include particular factual findings that support an assertion that a skilled artisan would have modified the express disclosure of Wu, Collins to develop the invention recited by independent claims 1, 9 and 17. See *In re Kotzab*, 55 USPQ2d 1313, 1317. Applicant is unable to discern the requisite factual basis in Wu, Collins or the Office Action.

In this regard, the Office Action appears to have engaged in a hindsight-based obviousness analysis condemned by the Federal Circuit. To prevent a hindsight-based obviousness analysis, the Federal Circuit has clearly established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine or modify references. See *Ruiz v. A.B. Chance Co.*, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000); see also *In Re Rouffet*, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("[T]he Board must identify specifically ... the reasons one of ordinary skill in the art would have been motivated to select the references and combine them to render the claimed invention obvious."). Applicant can detect, and the Office Action has pointed to, no motivation or suggestion that would prompt someone of ordinary in the art to look to Wu, Collins and Markham in combination for a solution to the problem addressed by Applicant's invention. Such a determination that there is a suggestion or motivation to modify Wu, Collins and Markham is a factual finding that is prerequisite to an ultimate conclusion of obviousness. *Sibia Neurosciences, Inc. v. Callus Pharma. Corp.*, 55 USPQ2d 1927, 1931 (Fed. Cir. 2000). Applicant respectfully submits that the Office Action is devoid of such a finding.

Without such a finding, a prima facie case of obviousness in rejecting claims 1, 8, 9, 16, 17 and 24 under 35 U.S.C. § 103(a) based on Wu, Collins has not been made. For this further reason, Applicant respectfully submits that claims 1, 8, 9, 16, 17 and 24 are patentably distinguished over Wu, Collins and Markham and Applicant respectfully requests the Examiner to remove the rejections of claims 1, 9 and 17 and the claims depending therefrom.

Examiner's response:

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be



expressly articulated. The test for combining references is not what individual references themselves suggest but rather what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re Keller, 648 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983); In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969).

### ***Examination Considerations***

12. The claims and only the claims form the metes and bounds of the invention. "Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, I 45-48; p 2100-9, c 1, I 1-4). The Examiner has the full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

13. Examiner's Notes are provided to assist the applicant to better understand the nature of the prior art, application of such prior art and, as appropriate, to further indicate other prior art that maybe applied in other office actions. Such comments are entirely consistent with the intent and sprit of compact prosecution. However, and unless otherwise stated, the Examiner's Notes are not prior art but link to prior art that one of ordinary skill in the art would find inherently appropriate.

14. Examiner's Opinion: Paragraphs 12 and 13 apply. The Examiner has full latitude to interpret each claim in the broadest reasonable sense.

### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Claims 1-24 are rejected.

***Correspondence Information***

17. Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner Peter Coughlan, whose telephone number is (571) 272-5990. The Examiner can be reached on Monday through Friday from 7:15 a.m. to 3:45 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor David Vincent can be reached at (571) 272-3687. Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,  
Washington, D. C. 20231;

Hand delivered to:

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Customer Service Window,  
Randolph Building,

Art Unit: 2129

401 Dulany Street,

Alexandria, Virginia 22313,

(located on the first floor of the south side of the Randolph Building);

or faxed to:

(571) 273-8300 (for formal communications intended for entry.)

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